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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,707	12/12/2001	Stuart Harbron	1904-004	2683

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MORGAN LEWIS & BOCKIUS LLP
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EXAMINER

CEPERLEY, MARY

ART UNIT PAPER NUMBER

1641

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/913,707

Applicant(s)

HARBON, STUART

Examiner

Mary (Molly) E. Ceperley

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☒ Claim(s) 9-11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1) The specification must be amended to include a section entitled "Brief Description of the Drawings".

2) Applicant is requested to provide an Information Disclosure Statement providing, at a minimum, **a)** a copy of the Harbron et al Analytical Biochemistry (1992) article cited as an "A" reference in the corresponding search report (reference not provided to the examiner) and **b)** all references cited in the specification which are specifically pertinent to the instantly claimed invention. Applicant, if he knows, is requested to indicate the identity of each of the references designated "D1" through "D5" in the International Preliminary Examination Report.

3) Although specific claims are cited in the rejections below, these rejections are also applicable to all other claims in which the noted problems/language occur.

4) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5) Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The method of detection claims are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a required step for contacting and binding the two members of a specific binding pair and; without this step no "binding event" would have occurred which could be "detected".

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b) In claim 7, the "1,2-dioxetane compound" must be "an esterifiable moiety" (since this compound is not $X = H$). However, it is unclear that the "1,2-dioxetane compound" is "esterifiable".

c) In claim 3, it is unclear what is meant by the term "a derivative" since the required function/nature of the "derivative" is unspecified. See also, the term "derivative" in claims 13 and 16-22.

d) In claim 8, there is no antecedent basis in claim 7 for the term "said 1,2-dioxetane phosphate".

e) Claim 14, reciting "NAD" and "NADH", is broader in scope than the term "3' nicotinamide derivative" of independent claim 13.

f) The exact scope of claim 16 cannot be determined since the required components of the "detection system" are unspecified.

6) Claims 9-11 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot be dependent from another multiple dependent claim (see claim 4). See MPEP § 608.01(n).

7) Fisher et al (U.S. 6,362,328), col. 2, lines 23-67, is cite to further show the state of the art.


8) An inquiry of a general nature which is **not related to the prosecution on the merits** should be directed to Technology Center 1600 telephone number (571) 272-1600. The general fax number for the USPTO is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
Long V. Le, can be reached on (571) 272-0823.

May 14, 2004


Mary (Molly) E. Ceperley
Primary Examiner
Art Unit 1641